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D-1077

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
Jay Paul Drummond, et al.)	
)	Art Unit: 2164
Serial No.: 09/077,337)	
)	
Filed: May 27, 1998)	Patent Examiner
)	James S. Bergin
Title: Automated Banking Machine)	
Apparatus and System)	

Director of Technology Center 2100
Commissioner for Patents
Washington, D.C. 20231

PETITION FOR WITHDRAWAL OF
RESTRICTION REQUIREMENT PURSUANT TO 37 C.F.R. § 1.144

Sir:

Applicants respectfully petition for withdrawal of the lack of unity of invention requirement ("restriction requirement") presented in the above referenced application in the Office Action dated April 24, 2001 (hereafter the "Action"). Reconsideration of the restriction requirement was requested pursuant to 37 C.F.R. § 1.143 on May 23, 2001. The request for reconsideration was denied and the restriction requirement was made Final in the Office Action dated June 19, 2001.

Applicants respectfully submit that the restriction requirement should be withdrawn as it is legally improper. In the Action claims 1-47 were made subject to a restriction requirement. In the request for reconsideration of May 23, 2001, Applicants provisionally elected with traverse Grouping III (claims 31, 35, 38, 41, 44, and 45). Applicants' request for reconsideration included an amendment with additional claims 48-54. These claims 48-54 were grouped with Grouping III in the Office Action dated June 19, 2001. Thus, provisionally elected Grouping III now includes claims 31, 35, 38, 41, 44, 45, and 48-54.

It is noted that a Declaration has been filed concurrently herewith. As discussed in more detail herein, this new Declaration renders moot the lack of unity of invention requirement.

Applicants respectfully submit that the restriction requirement is not valid, nor is the asserted basis for the restriction a valid basis for requiring restriction. Applicants respectfully request that the restriction requirement be withdrawn and that all of the claims 1-54 be examined.

The Alleged Groups Of Inventions

The present application is a U.S. national stage application filed under 35 U.S.C. § 371.

The Action alleges that the present application contains inventions or groups of inventions. The Applicants disagree. Applicants assert that the present claims relate to a common invention. Nevertheless, even if the present application relates to a group of inventions, it is respectfully submitted that each alleged group of inventions are so linked as to form a single general inventive concept.

For example, claim 21 was previously amended April 7, 2000 to be an independent claim by incorporation of subject matter of claim 1, from which it originally depended. Thus, Group II

(which contains claim 21) cannot be regarded as not linked so as to form a single general inventive concept with Group I (which contains claim 1). Therefore, it is respectfully submitted that unity of invention exists at least between the alleged Groups I and II.

The Office Admits That The Groups Share A Common Special Technical Feature

The Action admits (numbered paragraph 2) that all of the alleged Groups I-V ("groups") share a common special technical feature. The Action admits that the "groups 1-5 share the special technical feature of a note or document dispenser of a banking machine being in operative connection to a computer, said computer in connection with the banking machine." That is, the Office acknowledges a "special technical feature" common to all of the listed groups. 37 C.F.R. § 1.475 makes clear that unity of invention exists when there is a relationship among a group of inventions involving a "special technical feature." Hence, since the groups share a common special technical feature, which the Office freely admits, then it is respectfully submitted that unity of invention exists among all of the alleged groups in accordance with 37 C.F.R. § 1.475 and 37 C.F.R. § 1.499. Therefore, the restriction requirement is moot and should be withdrawn.

No Evidence That The Action's Alleged Technical Feature Is Well Known In The Prior Art

The Action alleges a technical feature directed to "a note or document dispenser of a banking machine being in operative connection to a computer, said computer in connection with the banking machine." The Action further alleges that "this technical feature discloses only that which is old in the art of banking machines and was well known to those of ordinary skill in the art at the time that the invention was made." The Applicants disagree.

The Office has provided no evidence that the alleged technical feature is well known in the prior art. The Office further fails to discuss any prior art reference disclosing the alleged technical feature. Additionally, as discussed in more detail herein, the new Declaration filed concurrently herewith further distances the alleged technical feature from being prior art.

Furthermore, as previously discussed, the Office admits that all of the groups share a common special technical feature. The expression "special technical feature" is defined (37 C.F.R. § 1.475) as meaning a technical feature that defines a contribution which each of the inventions, considered as a whole, makes over the prior art. Thus, by definition, the Office's admission that the groups share a common special technical feature is also an acknowledgment that the features of the groups avoid the prior art. Nor is it proper for the Office to recant an admission already of record.

The Claimed Invention Is Entitled To A Date Prior To All Applied Art

The earliest applied reference in the Office Action dated February 17, 2000 (U.S. Patent 5,761,071 to Bernstein) had a July 27, 1996 filing date. The present application is entitled to the priority of U.S. provisional application 60/031,956 filed November 27, 1996. As previously discussed in the amendment filed April 7, 2000, Applicants' claims patentably distinguish over the Bernstein reference. Nevertheless, Applicants submitted a Declaration pursuant to 37 C.F.R. § 1.131. The Declaration swore behind the Bernstein reference. The Office entered the Declaration and acknowledged (e.g., Interview Summary) the effective earlier date set forth by the Declaration.

A new Declaration has been submitted concurrently herewith pursuant to 37 C.F.R. § 1.131. The Office's reliance (in the Office Action dated June 19, 2001) on the alleged prior art publications "US Bancorp" and "Sun touts one-browser theory" references is moot in view of the new Declaration. That is, the Applicants have sworn behind the relied upon references.

The earliest applied reference (US Bancorp) allegedly has a February 16, 1996 date. Applicants' claims patentably distinguish over the US Bancorp reference. Nevertheless, the new Declaration swears behind the US Bancorp reference. The new Declaration, except for mention of the February 16, 1996 date and date of signature, is identical to the prior Declaration filed May 23, 2001. Thus, the Office has not presented one iota of evidence that the technical feature linking the alleged groups is well known in any "prior art." It follows that the Office has not shown that lack of unity exists. Hence, it is respectfully submitted that the lack of unity of invention requirement should be withdrawn.

Previously Indicated Allowable Subject Matter Established

That A Common Technical Feature Was Not Previously Known

In the Office Action dated February 17, 2000 claims 2-3 and 21-24 were indicated allowable if rewritten in independent form. These claims each had a linking special (allowable) technical feature including a "card reader." Claims 2 and 21 were amended April 7, 2000 to be independent claims by incorporation of subject matter of claim 1, from which they both depended. Although both claims 2 and 21 contained the special (allowable) technical feature including a "card reader" they were improperly placed in different groups in the lack of unity requirement. That is, claim 2 was placed in Group I, and claim 21 was placed in Group II.

However, Applicants argued that Group II could not be regarded as not forming a single general inventive concept with Group I. That is, because of the Office's indication of common allowable subject matter in these claims, the linking technical feature could not be viewed as well known in the art.

Now the Office, in order to avoid the clear contradiction of both admitting that claims 2 and 21 share a common special technical feature and having these claims placed in allegedly different groups, has recanted on the allowance of these claims. However, where do the relied upon US Bancorp or Sun references teach the recited "card reader"? Where is a teaching (prior to the effective date set forth in the new Declaration) of the recited features? It follows that a common special technical feature remains in these claims. Thus, the alleged different groupings for these claims continue to be improper. The allowance of these claims should be reinstated.

The Action Fails To Consider All Special Technical Features

As previously discussed, the Action of April 24, 2001 presenting the restriction requirement, alleges one technical feature directed to "a note or document dispenser of a banking machine being in operative connection to a computer, said computer in connection with the banking machine." However, it is respectfully submitted that (in accordance with 37 C.F.R. § 1.475) there is a technical relationship among the asserted groups involving one or more corresponding special technical features that the Office has overlooked. That is, all asserted groups share a common special technical feature which the Office failed to consider.

For example, all of the claims (in various forms) are generally directed to the common special technical feature involving some type of banking machine responsive to the receipt of a

markup language document to enable the dispense of a type of sheet. For example, in an exemplary embodiment, a banking machine is able to carry out one or more transaction functions, such as the dispensing of sheets, in response to an HTML document being received by the machine. The Office has provided no evidence that this common special technical feature is known in the prior art. Language generally corresponding to this special technical feature is shown as being common to each independent claim (1-2, 21, 31-32, 34-44, 46, and 51) below. It should be understood that the following reference to claim language in this Response is illustrative that this feature is common to the independent claims and is not associated with matters of patentability concerning prior art.

Claim 1

“operative responsive to the HTML document handling portion receiving an HTML format document including a dispense instruction to cause the sheet dispenser mechanism to dispense at least one sheet”

Claim 2

“operative responsive to the HTML document handling portion receiving a dispense instruction in an HTML format document, to enable the sheet dispenser mechanism to dispense at least one sheet”

Claim 21

“operative responsive to the HTML document handling portion receiving a dispense instruction in an HTML format document, to enable the sheet dispenser mechanism to dispense at least one sheet”

Claim 31

“the sheet dispenser mechanism is operative responsive to receipt of at least one HTML format document by the browser, to dispense at least one sheet from the ATM”

Claim 32

“dispensing at least one sheet from a sheet dispenser in the automated banking machine responsive to receipt by the browser of the HTML format document including the dispense instruction”

Claim 34

“dispensing at least one sheet from a sheet dispenser in the automated banking machine responsive to receipt by the browser of the document including the dispense instruction”

Claim 35

“responsive to receipt of at least one document by the browser, to enable the sheet dispenser mechanism to operate to dispense at least one sheet from the ATM”

Claim 36

“responsive to receipt by the browser of the document including the instruction in step (c), enabling a sheet dispenser in connection with the automated banking machine to operate to dispense at least one sheet”

Claim 37

“controlling a note dispenser in the automated banking machine responsive to receipt by the computer of the document including the instruction”

Claim 38

“the computer to operate to receive at least one document, and wherein the computer is operative responsive to the at least one HTML document to enable the sheet dispenser to dispense at least one sheet from the ATM”

Claim 39

“dispense of at least one sheet from a sheet dispenser in connection with the automated banking machine responsive to the computer receiving the document including the instruction”

Claim 40

“dispense of at least one note from the automated banking machine responsive to receipt by the computer of the HTML document including the instruction”

Claim 41

“computer is operative responsive to indicia read with the card reader to receive at least one document, and wherein the computer is operative to control the note dispenser in dispensing at least one note from the automated banking machine responsive to the at least one document”

Claim 42

“dispense of at least one note from the automated banking machine responsive to the at least one instruction included in the document received in step (b)”

Claim 43

“dispensing of at least one note from the banking machine responsive to the document received in step (c)”

Claim 44

“the computer is adapted to receive mark up language documents, and wherein the computer is adapted to operate responsive to at least one mark up language document to cause at least one note to be dispensed from the banking machine”

Claim 46

“computer to receive at least one mark up language document” “the computer responsive to the at least one mark up language document to cause at least one note to be dispensed from the banking machine”

Claim 51

"the computer is adapted to receive at least one mark up language document, and wherein the computer is adapted to operate responsive to the at least one mark up language document to cause at least one sheet to be dispensed from the automated banking machine"

The Action Does Not Meet The Requirements Necessary For Restriction Requirement

MPEP § 1893.03(d) states that "When making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group."

The Applicants respectfully submit that the Action of April 24, 2001 presenting the restriction requirement, does not satisfy item (1). The present application is not directed to different groups of claims. Even the Action admits that all of the groups share a common special technical feature. Thus, the listed groups are not "different."

The Applicants also respectfully submit that the Action of April 24, 2001 also does not meet the requirement of item (2). Nowhere in the Action does the Office explain why each asserted group lacks unity with each other group. The Action does not compare any group with any other group. It follows that the Action does not compare each group with each other group. The five (5) alleged groups would require at least ten (10) separate comparisons. Yet Applicants have not received even one comparison. Thus, the Action does not meet the burden of item (2), which is necessary to sustain the restriction requirement. Since an explanation (item (2)) has not

been provided, then the Action also does not comply with the procedural rules of the Office. Thus, the restriction requirement is defective and should be withdrawn.

Furthermore, nowhere in the Action does the Office specifically describe "the unique special technical feature in each group." That is, the Action of April 24, 2001 does not describe how each asserted group has a unique special technical feature not found in each other group. Contrarily, the Action admits that all of the groups share a common special technical feature. Again, the Action lacks any comparison whatsoever of any two groups. It follows that the Action lacks the required comparison of each individual group with each other individual group. Thus, the Action fails to specifically describe the unique special technical feature in each group, which is also necessary to sustain the restriction requirement.

The Action of April 24, 2001 states that each of the "groups 1-5 share the special technical feature." The Action also states that "this technical feature discloses only that which is old in the art of banking machines and was well known to those of ordinary skill in the art at the time that the invention was made. Thus, unity of invention between the inventive groups is defeated."

The Office's reasoning that each group shares the same special technical feature is not a valid basis for asserting lack of unity of invention. Furthermore, the Office's reasoning that each group shares an old technical feature is not a valid basis for asserting lack of unity of invention. The Office's reasoning that each group shares technical features and thereby a common unity, is directly contrary to the assertion that each group lacks a common unity.

The Action's statements, by indicating that each group shares in unity the same special technical feature, actually shows that unity of invention is present and that the Office has not met

the requirements for restriction. That is, the Action literally contradicts the Office's assertion that each group lacks unity with each other group. In other words, the Action's admission that each of the groups share a common unity, is the opposite to what the Office must prove before imposing a lack of unity requirement. It follows that the April 24, 2001 Action itself actually establishes that the restriction requirement is not appropriate.

It is respectfully submitted that the restriction requirement is incomprehensible, conflicting, and incomplete. It follows that the restriction requirement is defective. On this basis it is further respectfully submitted that the requirement should be withdrawn.

Applicants' Process And Apparatus Claims Are Entitled To Unity Of Invention

It is respectfully submitted that the relationship between the process and apparatus claims has not been properly considered. A national stage application will be considered to have unity of invention with claims drawn to a process and an apparatus designed for carrying out the process (37 C.F.R. § 1.475). There is no evidence that the Office ever considered the relationship between the process and apparatus claims. It follows that the Office has not met the requirements necessary for restriction requirement, and the Action of April 24, 2001 is defective. On this basis it is respectfully submitted that the requirement should be withdrawn.

It is respectfully submitted that the application has apparatus claims drawn to apparatus capable of carrying out process claims. Hence, in accordance with 37 C.F.R. § 1.475 the application has unity of invention. Thus, the alleged groups have unity of invention.

For example, the apparatus of claim 44 (Group III) is designed for carrying out the process of claim 46 (Group IV). Thus, Groups III and IV clearly have unity of invention. The

other groups likewise show some relationship between process and apparatus claims. For brevity only one comparison example (using claims 44 and 46) is provided. The below described relationship of claims 44 and 46 show that the apparatus (claim 44) can carry out the process (claim 46):

<u>Claim 44 apparatus feature</u>	<u>can carry out the</u>	<u>Claim 46 process step</u>
an automated banking machine comprising a computer, wherein the computer is adapted to receive mark up language documents;		(a) operating a computer in an automated banking machine, wherein the computer is adapted to receive mark up language documents;
wherein the computer is adapted to receive mark up language documents;		(b) operating the computer to receive at least one mark up language document;
wherein the computer is adapted to operate responsive to at least one mark up language document to cause at least one note to be dispensed from the banking machine.		(c) operating the computer responsive to the at least one mark up language document to cause at least one note to be dispensed from the banking machine.

The Definitions And Relationships Of The Alleged Groups Are Improper

Group I is allegedly directed to a banking machine comprising a computer.

Group II is allegedly directed to an apparatus comprising a home http server having a home address, said apparatus also comprising a banking machine, said banking machine further comprising a computer. However, it is noted that Group I is also directed to a banking machine comprising a computer. Thus, the alleged different groupings are improper.

Group III is allegedly directed to an automated teller machine. However, it is noted that the Group III independent claims (e.g., claims 31, 35, 38, 41, 44, and 51) are actually directed to an automated banking machine. Thus, the alleged grouping is improper.

Group IV is allegedly directed to a method of operating the computer of an automated banking machine to dispense at least one note. However, it is noted that independent method claim 43, which is listed with Group V, is also directed to operating the computer of an automated banking machine to dispense at least one note. Thus, the alleged different groupings are improper. Also, note claims 37, 40, and 42.

Group V is allegedly directed to a method comprising operating a browser in at least one computer in connection with an automated banking machine. However, it is noted that independent method claims 39, 40, 42, and 43 do not even mention a browser. Thus, the alleged grouping is improper.

Thus, the lack of unity of invention requirement, which is based on improper groupings, should be withdrawn.

Unity Of Invention Exists Between The Alleged Groups

Groups I and II

Alleged Group II contains independent claim 21. As previously discussed, claim 21 was previously amended April 7, 2000 to be an independent claim by incorporation of subject matter of claim 1 (Group I), from which it originally depended. Thus, Group II (which contains claim 21) cannot be regarded as not linked so as to form a single general inventive concept with Group I (which contains claim 1). Furthermore, the Action presenting the restriction requirement admits that Group II contains all of the features drawn to Group I. That is, the Action admits that Group II includes the Group I features of “a banking machine comprising a computer.” Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups I and II.

Groups I and III

The Action directs Group I to “a banking machine comprising a computer.” However, claims 31, 35, 38, 41, 44, and 51 of the alleged Group III also have a banking machine comprising a computer. Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups I and III.

Groups I and IV

The Action directs Group I to “a banking machine comprising a computer.” However, claim 46 of the alleged Group IV also has a banking machine comprising a computer. Furthermore, the Office has not shown that the apparatus of Group I is not capable of carrying out the process of Group IV. That is, the Office has not shown that the apparatus of Group I is

not capable of dispense. Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups I and IV.

Groups I and V

The Action asserts that Group I is directed to “a banking machine comprising a computer.” The Action states that Group V is directed to a computer in connection with a banking machine. Hence, the Action admits that Group V contains all of the features drawn to Group I. That is, the Action admits that Group V includes the Group I features of “a banking machine comprising a computer.” Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups I and V.

Groups II and III

It is respectfully submitted that claims 31, 35, 38, 41, 44, and 51 of the alleged Group III are directed to a banking machine comprising a computer. Hence, alleged Group III corresponds to alleged Group II which is also directed to a banking machine comprising a computer. Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups II and III.

Groups II and IV

The Action asserts that Group IV is directed to a method of operating the computer of an automated banking machine to dispense at least one note. However, the Office has not shown that the apparatus of Group II is not capable of carrying out the process of Group IV. That is, the Office has not shown that the apparatus of Group II is not capable of dispense.

Furthermore, the Action asserts that Group II is directed to a banking machine comprising a computer. However, claim 46 of the alleged Group IV also has a banking machine comprising

a computer. Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups II and IV.

Groups II and V

Group V is directed to a method comprising operating a browser in at least one computer in connection with an automated banking machine. As previously mentioned, claims 39, 40, 42, and 43 do not even mention a browser. The Office has not shown that the apparatus of Group II is not capable of carrying out the process of these Group V claims. Furthermore, the Action asserts that Groups II and V are both directed to having a banking machine comprising a computer. Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups II and V.

Groups III and IV

The Action asserts that Group III is directed to an “automated teller machine comprising a computer.” However, it is noted that independent claims 31, 35, 38, 41, 44, and 51, which are listed with Group III, are directed to a banking machine comprising a computer. Claim 46 of the alleged Group IV also recites a banking machine comprising a computer. Furthermore, as previously discussed in detail, claim 44 of Group III is capable of carrying out the process of Group IV claim 46. Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups III and IV.

Groups III and V

The Action asserts that Group III is directed to an “automated teller machine comprising a computer.” However, as previously discussed, it is respectfully submitted that alleged Group III claims 31, 35, 38, 41, 44, and 51 are directed to a banking machine comprising a computer. The

Action asserts that Group V is directed to a computer in connection with a banking machine.

Hence, the Action admits that Group V contains all of the features attributed to Group III.

Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups III and V.

Groups IV and V

The Action asserts that Group V is directed to a method comprising operating a browser in at least one computer in connection with an automated banking machine. As previously mentioned, claims 39, 40, 42, and 43 do not even mention a browser. Thus, the Group V language drawn to a computer in connection with an automated banking machine, generally corresponds to the alleged Group IV language drawn to a computer in an automated banking machine. Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups IV and V.

Furthermore, the alleged Group IV has language directed to dispense of at least one note. However, it is noted that independent method claim 43, which is listed with Group V, also has language directed to dispense of at least one note. Also, note claims 37, 40, and 42. Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups IV and V.

The Dependent Claims Have Not Been Considered

MPEP § 1850 indicates that if an independent claim does not avoid the prior art, then the question whether there is still an inventive link between all of the claims dependent on that claim needs to be carefully considered.

As previously discussed, the independent claims avoid the prior art and satisfy the requirement of unity of invention. Nevertheless, Applicants also assert that the dependent claims have an inventive link. Any inventive link between dependent claims must be absent before a holding of lack of unity of invention is proper. However, there is no evidence that the Office ever considered whether there existed an inventive link between the dependent claims. Nor has the Action presenting the restriction requirement or the subsequent Office Action established the absence of any inventive link between dependent claims, so as to overcome the assertion by Applicants that an inventive link exists. It follows that the Action further does not meet the requirements necessary for restriction requirement. Thus, Applicants submit that the Action is further defective. On this basis it is respectfully submitted that the requirement should be withdrawn.

Unity Of Invention Was Already Determined By The Office

The present application is a national stage (filed under 35 U.S.C. § 371) application of PCT/US97/21422. The Office in that PCT application determined that there was no lack of unity of invention. Therefore, the Office has already admitted that unity of invention exists. Hence, it is respectfully submitted that the restriction requirement should be withdrawn.

Additional Remarks In Response To The Comments In The Office Action
Dated June 19, 2001 Making The Restriction Requirement Final

A Valid Basis For A Lack Of Unity Of Invention Requirement Has Not Been Presented

The Office Action dated June 19, 2001 in making the requirement Final also admits that there is a "technical feature linking the groups." The Office attempts to solely base the requirement for lack of unity of invention requirement on the allegation that at least one technical feature linking the groups was already known at the time of the invention. However, the attempt is not a valid basis for a lack of unity of invention requirement. Furthermore, as previously discussed in detail, there are many other reasons as to why the requirement is not valid.

The Office Action dated June 19, 2001 alleges that unity of invention does not exist "because the technical feature linking the groups comprises only that which was already known to those of ordinary skill in the art at the time that the invention was made" and the "linking technical feature does not advance the level of knowledge in the art at the time that the invention was made and therefore does not comprise a linking special technical feature."

As previously discussed, the Applicants disagree. The allegation that groups are linked by at least one known technical feature is not a valid basis for a lack of unity of invention requirement. Furthermore, even if each claim in an application shared at least one element of previously known subject matter (which is probably the situation in most applications), this would still not be a valid reason for restriction requirement. Actually, it is the commonly shared subject matter that precludes restriction.

As previously discussed, MPEP 1893.03(d) sets forth some of the requirements the Office must show to establish lack of unity of invention. MPEP 1893.03(d) states that “When making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.” As previously discussed, the Office has not met the burdens of (1) or (2), nor explained how each group lacks unity with each other group by specifically describing the unique special technical feature in each respective group. That is, the Office has not provided a showing of a lack of unity of invention.

Furthermore, the Action of June 19, 2001 again admits that there is at least one common technical feature linking the groups. Thus, the Action admits that there is a single general inventive concept. Thus, unity of invention is not lacking. Even if it were proper for the Action to list different groups of claims (which it isn't), and if the claims lacked a common special technical feature in each group (which they don't), then the Office would still have to show why each group lacks unity with each other group (i.e., why there is no single general concept). However, the Action has not comparatively shown why each group lacks unity with each other group. Additionally, the Action admits that the alleged groups are commonly linked and that there is a single general concept.

The Office has admitted that there is a common technical feature linking each of the alleged groups. It follows that the alleged groups actually relate to a common invention and that unity of invention exists. However, the Office has alleged that a linking technical feature in the alleged groups was "already known to those of ordinary skill in the art at the time that the

invention was made." The Office then somehow uses this assertion to create arbitrary groupings. Even the Action dated June 19, 2001 admits that "The groupings of the claims arrived at by the examiner is at the discretion of the examiner, the groups being selected so as to reduce the examination burden to an acceptable level." Thus, it appears that the Office's reason for the lack of unity requirement is based on the Office's desire to "reduce the examination burden to an acceptable level" by arbitrarily creating groupings of the claims "at the discretion of the examiner" and then alleging that at least one linking technical feature in the groups is already known. Therefore, it is respectfully submitted that the reasoning, groupings, and actions of the Office are not in accordance with the statutes, rules, and Office procedures, and the restriction requirement should be withdrawn.

The Office Has Not Shown Evidence That The Linking Technical Feature Is Prior Art

As previously discussed, the Office Action dated June 19, 2001 admits that there is a "technical feature linking the groups." Applicants respectfully submit that at least one linking technical feature is not prior art to the claimed invention.

The lack of unity requirement relies on the teachings of the references "US Bancorp" and "Sun touts one-browser theory." However, where do these references teach that an automated banking machine is able to dispense a note (e.g., claims 44, 53)? Furthermore, neither US Bancorp nor Sun discuss or even remotely suggest the capability of printing (which would be counterfeiting) notes by using a PC (as alleged in the Action dated June 19, 2001), which (if somehow possible) would have been illegal. It follows that neither relied upon reference teaches

the admitted linking technical feature. Therefore, it is respectfully submitted that unity of invention exists.

**The Office's Reliance On The References Is Moot In View
Of The Claimed Invention Being Entitled To An Earlier Date**

Applicants traverse the allegation that the US Bancorp and Sun documents are citable publications. Applicants question the accuracy of the purported dates and content of the apparently electronic documents. Applicants request evidence of the actual publication of these documents and the dates thereof. Applicants request a non-electronic copy version of the allegedly published US Bancorp and Sun documents. Absent presentation of such a non-electronic copy bearing a date showing publication, the Office has failed to establish that these references are "printed publications" as is specifically required by 35 U.S.C. § 102 before such items may be cited.

Nevertheless, the Office's reliance on the US Bancorp and Sun references as prior art, to show that the technical feature linking the groups is already known, is moot in view of the new Declaration filed concurrently herewith. That is, as previously discussed, the Applicants have sworn behind the relied upon references. Thus, the US Bancorp and Sun references do not constitute prior art. Thus, the Office lacks evidence that the technical feature linking the alleged groups is well known in the prior art. Therefore, the Office's asserted basis for lack of unity of invention requirement is moot. Hence, it is respectfully submitted that the lack of unity of invention requirement should be withdrawn. Further as no prior art has been cited against the

claims, and no other objection has been presented, all the pending claims in the Application should be allowed.

CONCLUSION

For all the above reasons, it is respectfully submitted that there is no valid basis for requiring a lack of unity of invention requirement. Applicants respectfully request that their Petition be granted and the requirement withdrawn.

Respectfully submitted,



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